

REMARKS

By this Amendment, Applicant has replaced the specification with a substitute specification and attached a marked-up version of the substitute specification illustrating amendments to the specification. Applicant has also added new claims 56-61. Claims 1-50 and 52-61 remain pending.

In the last Office Action, the Examiner:

- a) objected to the specification for containing asserted informalities;
- b) rejected claims 1, 2, 6, 8-12, 21, 22, 26, 28-32, 41, 42, 46, 47, 52, 54, and 55 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,571,003 (*"Hillebrand"*);
- c) rejected claims 1, 2, 4, 6, 8, 10-12, 21, 22, 24, 26, 28, 30-32, 41, 42, 44, 46, 47, 49, 52, 54, and 55 under 35 U.S.C. § 102(a) as anticipated by *"EZ200 Digital Camera's User's Guide"* (*"EZ200 User's Guide"*);
- d) rejected claims 4, 7, 24, 27, 44, 49, 53, and 55 under 35 U.S.C. § 103(a) as unpatentable over *Hillebrand*;
- e) rejected claims 7, 27, and 55 under 35 U.S.C. § 103(a) as unpatentable over *EZ200 User's Guide*; and
- f) indicated claims 3, 5, 13-20, 23, 25, 33-40, 43, 45, 48, and 50 contain allowable subject matter.

Applicant thanks the Examiner for indicating claims 3, 5, 13-20, 23, 25, 33-40, 43, 45, 48, and 50 contain allowable subject matter.

OBJECTION TO SPECIFICATION

On page 2 of the Office Action, the Examiner objected to the specification for failing to include a reference to block 712 in Fig. 7, referring to a title of a provisional application in a non-English language at page 37 of the specification, referring to attorney docket numbers instead of application numbers, listing concurrently filed applications and a claim for priority on page 42 of the specification, and providing definitions at the end of the detailed description.

Applicant notes that the title of provisional application No. 60/331,003 listed at page 37 of specification is correct. The title of the provisional application as-filed is in French and does not require correction.

Applicant has submitted a **Substitute Specification** to address other objections to the specification. Specifically, the specification has been amended so that it now includes a reference to block 712 in Fig. 7, refers to application numbers instead of attorney docket numbers, lists concurrently filed applications and the claim for priority on page 1 of the specification, and provides definitions at the beginning of the detailed description.

A **Marked-Up Version of the Substitute Specification** illustrating the amendments to the specification, is attached.

No new matter has been added in the **Substitute Specification**.

REJECTION UNDER SECTION 102

Applicant respectfully requests withdrawal of the rejection of claims 1, 2, 6, 8-12, 21, 22, 26, 28-32, 41, 42, 46, 47, 52, 54, and 55 under 35 U.S.C. § 102(b) based on *Hillebrand*.¹

Applicant also respectfully requests withdrawal of the rejection of claims 1, 2, 4, 6, 8, 10-12, 21, 22, 24, 26, 28, 30-32, 41, 42, 44, 46, 47, 49, 52, 54, and 55 under 35 U.S.C. § 102(a) based on *EZ200 User's Guide*.

In order to properly anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly or under principles of inherency, in a single prior art reference. "The identical invention must be shown in as complete detail as is contained in the . . . claim[s]." See M.P.E.P. § 2131 (8th Ed. May 2004). And, "[t]he elements must be arranged as required by the claim." *Id.*

For independent claim 1, neither *Hillebrand* nor *EZ200 User's Guide* teaches "sending a signal to the display device to cause a screen of the display device to generate light in a predetermined wave length range for irradiating the body part" and "capturing an image of the body part with [an] image capture device while the body part is irradiated with the light, in the predetermined wave length range, emitted from the screen of the display device," as recited in the claim.

¹ *Hillebrand* does not qualify as prior art under 35 U.S.C. § 102(b), but for the purposes of this Amendment, Applicant assumes the Examiner is making a rejection under 35 U.S.C. § 102(e). If the Examiner continues to reject the claims in an anticipation rejection based on *Hillebrand*, Applicant respectfully requests that the Examiner confirm whether she intended to make the rejection under 35 U.S.C. § 102(e).

Hillebrand merely discloses an imaging rig 104 that includes positioning equipment 116, lights 118, and a digital camera. *Hillebrand*, col. 3, lines 46-48. Imaging rig 104 is connected to computing device 106, which is connected to a display 108. *Id.*, col. 3, lines 58-60. *EZ200 User's Guide* merely discloses taking still pictures with a digital camera that is on top of PC monitor. *EZ200 User's Guide*, p. 24. Neither one of these references discloses sending a signal to a display device to cause a screen of the display device to generate light in a predetermined wave length range for irradiating a body part and capturing an image of the body part with an image capture device while the body part is irradiated with the light, in the predetermined wave length range, emitted from the screen of the display device.

On page 3 of the Office Action, the Examiner apparently admits that neither *Hillebrand* nor *EZ200 User's Guide* expressly teaches the “sending” and “capturing” features of claim 1, and the Office Action asserts that “light will *inherently* irradiate the body part being imaged by the camera” (emphasis added).

Applicant respectfully submits that the anticipation rejections should be withdrawn because nothing supports the inherency assertions in the Office Action. Inherency requires that “. . . evidence. . . make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” M.P.E.P. § 2131.01(III) (citations omitted). “Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.” *Scaltech, Inc. v. Retec/Tetra, L.L.C.*, 178 F.3d 1378, 1384 (Fed. Cir. 1999).

Similarly, the inherent result must be an absolute occurrence, an occasional result is not sufficient. *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999).

The Office Action does not provide any evidence demonstrating that *Hillebrand* or *EZ200 User's Guide* inherently teaches the “sending” and “capturing” features of claim 1. More specifically, the Office Action does not meet the burden of establishing that the “sending” and “capturing” features are necessarily present and an absolute occurrence in *Hillebrand* and *EZ200 User's Guide*. For example, the techniques disclosed in *Hillebrand* and *EZ200 User's Guide* would clearly be capable of being performed without having the “sending” and/or “capturing” features of claim 1. Even hypothetically if it might be somehow possible to have the “sending” and “capturing” features of claim 1 result from the circumstances described in *Hillebrand* and *EZ200 User's Guide*, such a hypothetical possibility is not sufficient to support anticipation under an inherency theory.

Accordingly, the Section 102 rejections of claim 1 over *Hillebrand* and *EZ200 User's Guide* are not supported by either of the cited references and should be withdrawn.

For dependent claims 2, 4, 6, and 8-12, the Section 102 rejections over *Hillebrand* and *EZ200 User's Guide* should be withdrawn because these claims depend upon claim 1. As discussed above, neither *Hillebrand* nor *EZ200 User's Guide* teaches every element recited in claim 1 and therefore they do not teach every element recited in claims depending upon claim 1.

For independent claim 21, neither *Hillebrand* nor *EZ200 User's Guide* teaches “means for sending a signal to the display device to generate light in a predetermined

wave length range for irradiating the body part” and “means for capturing an image of the body part with the image capture device while the body part is irradiated with the light, in the predetermined wave length range, emitted from the display device,” as recited in the claim. On page 3 of the Office Action, the Examiner apparently admits that *Hillebrand* and *EZ200 User’s Guide* do not expressly teach the “means for sending” and the “means for capturing” elements, and the Office Action asserts that “light will *inherently* irradiate the body part being imaged by the camera” (emphasis added).

The Office Action, however, does not provide any evidence demonstrating that *Hillebrand* or *EZ200 User’s Guide* inherently teaches the “means for sending” and the “means for capturing” elements. The Office Action does not meet the burden of establishing that the “means for sending” and the “means for capturing” elements are absolutely and necessarily present in *Hillebrand* and *EZ200 User’s Guide*. The mere hypothetical possibility that the “means for sending” and the “means for capturing” element might result from the circumstances described in *Hillebrand* or *EZ200 User’s Guide* is not sufficient to support the claim rejection based on inherency.

Accordingly, the Section 102 rejections of claim 21 over *Hillebrand* and *EZ200 User’s Guide* are not supported by either of the cited references and should be withdrawn.

For dependent claims 22, 24, 26, and 28-32, the Section 102 rejections over *Hillebrand* and *EZ200 User’s Guide* should be withdrawn because these claims depend upon claim 21, and as discussed above, neither *Hillebrand* nor *EZ200 User’s Guide* teaches every element recited in claim 21.

Independent claims 41 and 46 have different scopes from independent claims 1 and 21, but claim 41 contains the same “sending” and “capturing” recitations as claim 1, and claim 46 recites a “means for sending” and a “means for capturing” having at least some similarity to the sending means and capturing means of claim 21. Hence, the Section 102 rejections of claims 41 and 46 over *Hillebrand* and *EZ200 User’s Guide* should be withdrawn for reasons similar to the ones discussed above for claims 1 and 21.

For dependent claims 42, 44, 47, and 49, the Section 102 rejection of these claims should be withdrawn at least by virtue of their dependence upon allowable claims 41 and 46.

For independent claim 54, the Section 102 rejections based on *Hillebrand* and *EZ200 User’s Guide* should be withdrawn because neither *Hillebrand* nor *EZ200 User’s Guide* teaches “a driver for driving [an] image capture device to capture [a] body condition image of [a] subject, wherein the image capture device, the driver and. . . at least one tool are packaged and distributed together in order to facilitate an electronic beauty analysis, and wherein the driver sends a signal to a display device to generate light in a predetermined wave length range for irradiating the body part during an image capture,” as recited in the claim. On page 2 of the Office Action, the Examiner apparently admits that neither *Hillebrand* nor *EZ200 User’s Guide* expressly teaches the “driver” limitation, and, as mentioned above, the Office Action asserts that “light will *inherently* irradiate the body part being imaged by the camera” (emphasis added).

The Office Action, however, does not provide any evidence demonstrating that *Hillebrand* or *EZ200 User’s Guide* inherently teaches the “driver” limitation. For

example, the Office Action does not meet the burden of showing that the “driver” limitation is absolutely and necessarily present in *Hillebrand* and *EZ200 User’s Guide*. Accordingly, the Section 102 rejections of claim 54 over *Hillebrand* and *EZ200 User’s Guide* are not supported by either of the cited references and should be withdrawn.

For dependent claim 52, the Section 102 rejection over *Hillebrand* or *EZ200 User’s Guide* should be withdrawn because this claim depends upon amended claim 54 and neither *Hillebrand* nor *EZ200 User’s Guide* teaches every element recited in amended claim 54 as discussed above.

For independent claim 55, the Section 102 rejections over *Hillebrand* and *EZ200 User’s Guide* should be withdrawn because neither *Hillebrand* nor *EZ200 User’s Guide* teaches “sending a signal to [a] display device to vary an intensity of light emitted from the display device” and “capturing a plurality of images of the body part with the image capture device while the body part is irradiated with varying intensities of light emitted from the display device,” as recited in the claim.

The Office Action does not provide any evidence demonstrating that *Hillebrand* or *EZ200 User’s Guide* inherently teaches the “sending” and “capturing” features of claim 55. The Office Action does not meet the burden of showing that the “sending” and “capturing” features of claim 55 are absolutely and necessarily present in *Hillebrand* and *EZ200 User’s Guide*. Consequently, the Section 102 rejections of claim 55 should be withdrawn.

REJECTION UNDER SECTION 103

Applicant respectively requests withdrawal of the rejection(s) of claims 4, 7, 24, 27, 44, 49, 53, and 55 under 35 U.S.C. § 103(a) as unpatentable over *Hillebrand* and/or

EZ200 User's Guide because *prima facie* obviousness has not been established with respect to these claims.

To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143.

Claims 4, 7, 24, 27, 44, 49, and 53 depend upon independent claims 1, 21, 41, 46, and 54, respectively. As discussed above, neither *Hillebrand* nor *EZ200 User's Guide* teaches each and every element recited in independent claims 1, 21, 41, 46, and 54. As discussed above, the Office Action does not provide evidence demonstrating that *Hillebrand* or *EZ200 User's Guide* teaches the recited features of claims 1, 21, 41, 46, and 54. Furthermore, neither *Hillebrand* nor *EZ200 User's Guide* suggests each and every element recited in claims 1, 21, 41, 46, and 54. Hence, at least by virtue of their dependence upon claims 1, 21, 41, 46, and 54, the Section 103 rejection of dependent claims 4, 7, 24, 27, 44, 49, and 53 under *Hillebrand* or *EZ200 User's Guide* is not supported by the cited references.

Additionally, for claim 53, the Examiner has failed to provide a sufficient motivation or suggestion for modifying *Hillebrand* to include a pH indicator, sebutape, or

a corneodisque indicator as a tool. On page 4 of the Office Action, the Examiner asserts that “the tool used to gather data would have been an obvious design choice of known equivalents in the absence of any showing of criticality.” Such an assertion fails to meet the burden necessarily to establish a *prima facie* case of obviousness. The M.P.E.P. requires that a suggestion or motivation to modify a reference must either be in the reference or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. § 2143. The Examiner has not provided evidence of any sufficient suggestion or motivation from either the reference or the knowledge generally available to one of ordinary skill in the art. Since nothing supplies any suggestion or motivation to modify *Hillebrand* to include a pH indicator, sebutape, or a corneodisque indicator, the Section 103 rejection of claim 53 should be withdrawn.

For claim 55, neither *Hillebrand* nor *EZ200 User's Guide* teaches or suggests each and every element recited in the claim. As discussed above, nothing in either *Hillebrand* or *EZ200 User's Guide* teaches the “sending” and “capturing” features of claim 55. In addition, there is no suggestion of those features. Hence, the Section 103 rejections of claim 55 based on *Hillebrand* and *EZ200 User's Guide* are not supported by the cited references.

Accordingly, the Examiner has not established *prima facie* obviousness under 35 U.S.C. § 103(a) for claims 4, 7, 24, 27, 44, 49, 53, and 55, and the Section 103 rejections should be withdrawn.

On page 4 of the Office Action, the Examiner alleges that it is well known to use artificial intelligence in the processing of images. To the extent the Office Action is relying on Official Notice in alleging that certain subject matter was well known,

Applicant calls attention to the provisions of M.P.E.P. § 2144.03, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based.

Applicant submits that the features recited in claims 7 and 27 are not unquestionably well-known, and the Office Action has failed to demonstrate the contrary. Simply stating that features of a system and method were well known does not establish that such subject matter is in fact unquestionably well-known. As M.P.E.P. § 2144.03 makes clear, “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted). Although the Office Action alleges that artificial intelligence in the processing of images is well known, the Office Action does not provide substantial evidence on the record to show that the claimed subject matter was in fact unquestionably well known. Accordingly, Applicant expressly traverses any taking of Official Notice that the features of claims 7 and 27 were well known.

NEW CLAIMS 56-61

Applicant has added new claims 56-61. Claims 56-61 are allowable at least by virtue of their dependence upon allowable claims 1, 21, 41, 46, 54, and 55, respectively, in addition to the patentable subject matter recited therein.

CONCLUSION

Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

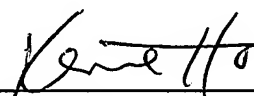
Applicant notes that the Office Action contains numerous statements reflecting apparent assertions concerning the related art and claims. Regardless of whether any such statement is addressed specifically herein, Applicant declines to automatically subscribe to any assertion and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: August 15, 2005

By: 
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Attachments:
Substitute Specification
Marked-Up Version of the Substitute Specification